

REMARKS

Applicants respectfully request that prosecution be reopened. Entry of the amendment is respectfully requested. Reconsideration is respectfully requested.

Claims 1-8, 11, 13-20, and 23-29 are pending. Claims 29-33 have been added to replace canceled claims 9-10, 12, and 21-22. Claims 6, 8, 11, 14, 18, 20, 23, and 24 have been amended. No new matter has been added.

The Rejections

Claims 6-7, 11, 13-16, 18-20, and 23 were newly rejected pursuant to 37 C.F.R. § 41.50(b) in the Board decision mailed April 18, 2008. The new rejections are:

- 1). Claims 13-15, 18, and 20 were rejected pursuant to 35 U.S.C. § 103(a) over Wagner in view of Dasan, Lawlor, Simmons, and Clausing.
- 2). Claims 6, 7, 11, and 23 were rejected pursuant to 35 U.S.C. § 103(a) over Wagner in view of Dasan, Lawlor, Simmons, and Patterson.
- 3). Claim 16 was rejected pursuant to 35 U.S.C. § 103(a) over Wagner in view of Dasan, Lawlor, Simmons, Clausing, and Patterson.
- 4). Claim 19 was rejected pursuant to 35 U.S.C. § 103(a) over Wagner in view of Dasan, Lawlor, Simmons, Clausing, and Martin.

Acknowledgment of allowability by the Board

Claim 17 was deemed allowable in the Board decision. Applicants reserve the right, subsequent to final action by the Board on the deferred affirmance, to later place claim 17 into an independent format.

Arguments

Applicants respectfully traverse the new rejections. Nevertheless, claims have been amended to advance prosecution. As can be seen, claims 6, 11, 14, 18, and 23 have been amended to recite additional specific features and relationships that further patentably distinguish these claims over the applied art.

Claim 6

The decision at page 24 states “Dependent claims 6 . . . require using the customer profile for selecting a language . . . and modifying the language . . . The Examiner essentially found that the ATM’s in Wagner performed these functions”. The Statement is unclear as the Office previously admitted (e.g., the Examiner’s Answer at page 12) that Wagner did not teach or suggest the recited features and relationships. Nor does Wagner discuss any “language” in the manner recited.

The decision at page 25 states “The Examiner took official notice for the pre-existence of language selection”. This Statement is also unclear. Nowhere in the Examiner’s Answer regarding claim 6 did the Examiner assert “official notice”. Thus, the Board’s new reliance on Gatto to apparently support this (alleged) assertion of “official notice” is further unclear.

Patterson (at col. 1, lines 21-28) mentions an ATM which operates in a predictive manner to predict the transaction most likely to be requested by the user, in accordance with that user’s habitual transaction requests. In Patterson, language is not a transaction. Nor does Patterson discuss or mention “language”. Nor does Patterson predict, based on a user’s habitual transaction requests, which language the user would request. Nor does Patterson have any need

to predict a language, especially since a user would not be in the habit of changing their language so often that predictive analysis would be required.

Gatto merely indicates (at col. 1, lines 23-24) that a user can conventionally manually use keys to select “the language for the display (English, Spanish, etc.)”. Gatto is actually directed to having user-defined transactions be displayed on a customized menu for the user (e.g., col. 8, lines 29-32). Gatto defines transactions (e.g., col. 3, lines 12-31). In Gatto, changing a language is not a transaction. Thus, Gatto cannot alleviate the deficiencies of Patterson.

The Office has not established a *prima facie* showing of obviousness. Nor would it have been obvious to one having ordinary skill in the art to have modified the applied references in the manner alleged to have produced the recited method of claim 6.

Claim 11

The decision at pages 24-25 states “Dependent claims . . . 11 require using the customer profile for selecting . . . and modifying . . . last withdrawal amount. The Examiner essentially found that the ATM’s in Wagner performed these functions, except for tracking the last withdrawal amount”. The Statement is unclear because the Office previously admitted (e.g., the Examiner’s Answer at pages 12-13) that Wagner did not teach or suggest the recited features and relationships. Nor does Wagner discuss any “last withdrawal amount” in the manner recited.

The remainder of the decision’s discussion regarding the rejection of claim 11 (i.e., at decision pages 25-26) fails to even address the recited feature of the “last withdrawal amount”. Thus, no *prima facie* showing of obviousness has been established by the Board.

Patterson's predictive manner to predict the transaction most likely to be requested by the user does not correspond to the recited "last withdrawal amount" feature. Nor is there any need for Patterson to predict, based on a user's habitual transaction requests, what factually occurred (e.g., the last withdrawal amount). Thus, Patterson teaches away from (and is non analogous to) a selectable option of a "last withdrawal amount". Gatto likewise does not teach or suggest the "last withdrawal amount" feature.

The Office has not established a *prima facie* case of obviousness. Nor would it have been obvious to one having ordinary skill in the art to have modified the applied references in the manner alleged to have produced the recited method of claim 11.

Claim 14

The Board (at decision pages 27-28) relies on Clausing to alleviate the admitted deficiencies of the other references with regard to "the customer type value corresponds to a servicer of automated transaction machines and the web page includes a plurality of selectable servicer options for servicing the automated transaction machine". However, Clausing does not discuss a "servicer". Therefore, the Board, without any supporting evidence of record, alleged (at decision page 28) that "a servicer is simply one who provides service, and operating a piece of equipment is a form of service, as the machine is in service".

This allegation by the Board lacks any basis, is without merit, and is just another example of the faulty decision reading like a fiction novel. Applicants' specification provided ample support for an automated transaction machine servicer. Further, one of ordinary skill in the art easily understands what constitutes a "servicer of automated transaction machines". There is an entire servicer industry. The record shows that even the Examiner understood the widely

accepted “servicer” term. The unreasonable definition by the Board attributed to the recited “servicer” language is further evidence that the Board did not correctly apply the standard of review to that of one of ordinary skill in the art.

The Office has not established a *prima facie* case of obviousness. Nor would it have been obvious to one having ordinary skill in the art to have modified the applied references in the manner alleged to have produced the recited method of claim 14.

Claim 18

The Board (at decision pages 27-28) relies on Clausing to alleviate the admitted deficiencies of the other references with regard to “the customer type value corresponds to a first class of customer, the web page includes a first option to perform a first transaction with the automated transaction machine, wherein when the customer type corresponds to second class of customers, the web page does not include the first option”. However, Clausing is not directed to displaying a web page that has a plurality of customer selectable options, including a cash withdrawal transaction selection option. Nor does Clausing relate displaying one web page (having the cash withdrawal transaction selection option and a bill pay option) to a first class of customer, and another (different) web page (having the cash withdrawal transaction selection option but not the bill pay option) to a second class of customer. Clausing does not *display* specific options. Clausing has transaction selector keys (31), including deposit/payment selector keys (32), cash withdrawal selector keys (34), and fund transfer selector keys (35). A customer in Clausing is not limited in what transactions can be selected (or attempted) by a customer. Rather, any customer in Clausing can select any of the easily reachable keys (31).

The Office has not established a *prima facie* case of obviousness. Nor would it have been obvious to one having ordinary skill in the art to have modified the applied references in the manner alleged to have produced the recited method of claim 18.

Claim 23

The references do not teach or suggest using marketing information of a customer profile in the manner recited, including retrieving, determining from, and updating the marketing information. Nor do the references teach or suggest displaying an ATM web page of a targeted advertisement which has plural customer selectable options with one of the options corresponding to a particular promotion, especially where the targeted advertisement was selected responsive to a determination made based on the marketing information.

The Office has not established a *prima facie* case of obviousness. Nor would it have been obvious to one having ordinary skill in the art to have modified the applied references in the manner alleged to have produced the recited method of claim 23.

The Declaration Pursuant to 37 C.F.R. § 1.132

The attached declaration under 37 C.F.R. § 1.132 further negates the reasoning relied upon by the Board in the decision. The declaration provides evidence that it would not have been obvious to a person having ordinary skill in the art at the time of the invention to have combined the applied references in the manner reasoned by the Board, especially to have produced the recited invention (as set forth in the appealed claims).

The Decision Is Legally Improper

The decision was decided by at least one person who was unconstitutionally appointed (by a PTO director) as a patent appeals judge. Thus, the decision rendered by the Board (and mailed April 18, 2008) is *prima facie* moot. As a result, the original appealed claims remain pending and await a decision by a Board panel comprised of patent appeals judges appointed in a constitutional manner.

Lack of evidentiary rebuttal by the Office regarding Applicants' accusation that the Board panel that rendered the decision did not have legal authority to do so, will be taken as an admission by the Office confirming the illegality of the decision. Applicants reserve all rights regarding the originally appealed claims, including a new full review thereof by a proper Board panel.

The Gatto Reference

Applicants request that the Gatto reference mentioned in the decision be properly made of record by being listed on form PTO-892.

Conclusion

The undersigned is willing to discuss any aspect of the Application at the Office's convenience.

Respectfully submitted,



Ralph E. Jocke Reg. No. 31,029
WALKER & JOCKE
231 South Broadway
Medina, Ohio 44256
(330) 721-0000